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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,087	09/25/2003	Scott E. Sampson	51763/3	6319
7590 STOEL RIVES LLP One Utah Center 201 South Main Street, Suite 1100 Salt Lake City, UT 84111				
07/02/2008				
EXAMINER				
OYEBISI, OJO O				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,087

Applicant(s)

SAMPSON, SCOTT E.

Examiner

OJO O. OYEBISI

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 31-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-28 and 31-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB088)
Paper No(s)/Mail Date 02/10/06, 04/15/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

In response to the restriction requirement mailed January 15th, 2008, the applicant has elected the Invention of Group I (claims 1-28 and 31-43) without traverse. Applicant's election of Group I (claims 1-28 and 31-43) is hereby acknowledged.

Claim Rejections - 35 USC §101

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-28 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

Art Unit: 3696

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory. Note that for a claimed invention to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied. In this particular case, the claim does not positively recite the other statutory class (the thing or product) to which it is tied.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-10, 14-28, 31-35, and 39-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Checchio (US PAT: 6,023,682).

Re claim 1. Checchio discloses a method comprising: associating a plurality of tokens with a financial account by recording the plurality of tokens in a token log, which token log is accessible by an institution that is responsible for authorizing one or more transactions involving the account (i.e., the credit card company, see fig.1 element s6); and initiating a transaction involving the financial account by providing one of the tokens

and an indication of the account to a vendor (i.e., merchant) (see fig.1 elements s2 and s3), wherein the vendor is to provide the token, the indication of the account, and information about the transaction to the authorizing institution (see fig.1 element s5), which authorizing institution provides the vendor with transaction authorization based on the token being found to exist in the token log (see fig.1 element s8).

Re claim 2. Checchio further discloses the method of claim 1, further comprising: receiving the token, the indication of the account, and the transaction information from the vendor; checking whether the token exists in the token log; and notifying the vendor that the transaction is authorized based on the token being found to exist in the token log (see col.3 lines 9-46).

Re claim 3. Checchio further discloses a method comprising: associating a token with one or more conditions in a token log that is accessible by an institution that is responsible for authorizing one or more transactions involving a financial account (i.e., the credit card company, see fig.1 element s6); and initiating a transaction involving the financial account by providing the token and an indication of the account to a vendor (see fig.1 elements s2 and s3), wherein the vendor is to provide the token, the indication of the account, and information about the transaction to the institution responsible for authorizing that transaction (see fig.1 element s5), which authorizing institution provides the vendor with transaction authorization based on the one or more conditions associated with the token in the token log being satisfied (see fig.1 element s8).

Re claim 4. Checchio further discloses the method of claim 3, further comprising: receiving the token, the indication of the account, and the transaction information from the vendor; checking whether the token exists in the token log; and notifying the vendor that the transaction is authorized based on the token being found to exist in the token log (see col.3 lines 9-46).

Re claim 5. Checchio further discloses a method comprising: receiving from an account holder an indication of one or more conditions for completing one or more transactions (see fig.1 element s2); associating a token with the one or more conditions in a token log that is accessible by an institution that is responsible for authorizing one or more transactions involving a financial account (i.e., the credit card company, see fig.1 element s6); and initiating a transaction involving the financial account by providing the token and an indication of the account to a vendor (see fig.1 elements s2 and s3),, wherein the vendor is to provide the token, the indication of the account, and information about the transaction to the institution responsible for authorizing that transaction (see fig.1 element s5), which authorizing institution provides the vendor with transaction authorization based on the one or more conditions associated with the token in the token log being satisfied (see fig.1 element s8).

Re claim 6. Checchio further discloses the method of claim 5, further comprising: receiving the token, the indication of the account, and the transaction information from

Art Unit: 3696

the vendor; checking whether the one or more conditions associated with the token in the token log are satisfied; and notifying the vendor that the transaction is authorized responsive to the one or more conditions being satisfied (see col.3 lines 9-46).

Re claim 7. Checchio further discloses the method of claim 5, wherein the indication of the account is one of a credit card number, a debit card number, an online payment number, a merchant account number, and a bank account number (see the abstract).

Re claim 8. Checchio further discloses the method of claim 5, wherein the token log comprises a data structure that associates specific tokens with one or more specific transaction conditions (see col.3 lines 9-46).

Re claim 9. Checchio further discloses the method of claim 5, wherein a transaction condition includes a maximum monetary amount for one or more specific transactions (i.e., purchase amount, see fig. 1 element s3).

Re claim 10. Checchio further discloses the method of claim 5, wherein a transaction condition includes a pattern to match a name of the vendor for one or more specific transactions (see col.3 lines 9-46).

Re claim 14. Checchio further discloses the method of claim 5, wherein a transaction condition includes the existence of a specific token in the token log (see col.3 lines 9-

Art Unit: 3696

46).

Re claim 15. Checchio further discloses the method of claim 5, wherein a transaction condition includes a mechanism for non-repudiation of the financial transaction (see col.3 lines 9-46).

Re claim 16. Checchio further discloses the method of claim 6, wherein the token log is stored in a communication device of the account holder (see the abstract, also see col.3 lines 9-48)

Re claim 17. Checchio further discloses the method of claim 16, wherein the communication device is one of a telephone, a cell phone, a desktop computer, and a portable computing device (see the abstract).

Re claim 18. Checchio further discloses the method of claim 16, wherein checking whether the at least one condition associated with the token in the token log is satisfied is accomplished by polling the account holder's communication device (see col.4 lines 14-40).

Re claim 19. Checchio further discloses the method of claim 18, wherein polling the account holder's communication device comprises: sending to the account holder's communication device a structured message containing transaction information and the specific token; and receiving from the account holder's communication device a

Art Unit: 3696

structured message indicating whether the transaction is approved or denied based on the satisfaction of the one or more conditions (see col.3 lines 9-48, col.4 lines 13-32).

Re claim 20. Checchio further discloses the method of claim 18, wherein polling the account holder's communication device includes: sending to the account holder's communication device a structured message containing the specific token; receiving from the account holder's communication device information from the token log pertaining to the given token; and using the information to determine if the transaction should be approved or denied (see col.3 lines 9-48, col.4 lines 13-32).

Re claim 21. Checchio further discloses the method of claim 6, wherein the token log is stored at the location of the institution responsible for authorizing one or more transactions involving the financial account (see the abstract, also see col.3 lines 9-48).

Re claim 22. Checchio further discloses the method of claim 6, wherein the token log is stored at a third-party location accessible to both the account holder and the institution responsible for authorizing one or more transactions involving the financial account (see the abstract, also see col.3 lines 9-48)

Re claim 23. Checchio further discloses the method of claim 6, wherein the vendor (i.e., merchant) is one of a seller of physical goods, a seller of services, a charitable organization, and an organization to which the account holder owes money (see the

Art Unit: 3696

abstract).

Re claim 24. Checchio further discloses the method of claim 5, wherein associating one or more tokens includes receiving the at least one condition for the one or more tokens from an external source (see col.3 lines 8-47).

Re claim 25. Checchio further discloses the method of claim 5, wherein entries in the token log include an indication of a type of transaction corresponding to one or more specific tokens (see col.3 lines 9-48, col.4 lines 13-32).

Re claim 26. Checchio further discloses the method of claim 5, further comprising automatically creating one or more token within a communication device of the account holder (see fig.1 element s3).

Re claim 27. Checchio further discloses the method of claim 5, wherein providing the token to a vendor includes entering a pass code in order to access the desired token (see fig.1 element s2).

Re claim 28. Checchio further discloses the method of claim 5, wherein providing the token to a vendor includes presenting a token that is known by the account holder to have been previously stored in the token log (see col.3 lines 9-47).

Re claim 31. Checchio further discloses a system comprising: a token creator to enter and store one or more tokens (see fig.1 element s3, see the abstract, also see col.3 lines 9-48).; a token log to associate specific tokens with specific conditions under which specific financial transactions will be valid (see fig.1 element s6); and a token access sub-system to make one or more tokens available to an account holder for distribution to one or more vendors involved in transactions pertaining to an account of the account holder (see fig.1 element s5, also see col.4 lines 15-40), wherein each vendor is to provide a specific token, an indication of the account, and information about a transaction to an institution responsible for authorizing one or more transactions involving the account (see fig.1 element s5), which institution authorizes each vendor to complete each vendor's transaction responsive to the specific conditions associated with each specific token in the token log being satisfied (see fig.1 element s8, also see col.4 lines 15-40)

Re claim 32. Checchio further discloses the system of claim 31, wherein the indication of an account is one of a credit card number, a debit card number, an online payment number, a merchant account number, and a bank account number (see the abstract).

Re claim 33. Checchio further discloses the system of claim 31, wherein the token log comprises a data structure that associates specific tokens with one or more specific transaction conditions (see fig.1 element s6)

Art Unit: 3696

Re claim 34. Checchio further discloses the system of claim 31, wherein the specific conditions include a maximum monetary amount for one or more specific transactions (see the abstract)

Re claim 35. Checchio further discloses the system of claim 31, wherein the specific conditions include a pattern to match a name of the vendor for one or more specific transactions (see the abstract)

Re claim 39. Checchio further discloses the system of claim 31, wherein the specific conditions include the existence of a specific token in the token log (see col.3 lines 9-46).

Re claim 40. Checchio further discloses the system comprising: a communication interface for receiving a token, an indication of an account, and information about a transaction from a vendor (see fig.1 element s5); a transaction authorization module for checking whether at least one condition associated with the token in the token log is satisfied (i.e., a token match, see fig.1 element s8, also see col.3 lines 9-46); wherein the communication interface is to notify the vendor that the transaction is authorized responsive to the at least one condition being satisfied (see col.4 lines 5-14) (see col.3 lines 10-66, more specifically col.3 lines 47-66).

Re claim 41. Checchio further discloses an apparatus comprising: means for storing

one or more tokens in a token log (see col.3 lines 30-34); means for associating each token with conditions under which specific financial transactions are valid (see col.3 lines 47-52); means for accessing tokens so that they can be associated with specific financial transactions (see col.4 lines 5-12); and means for authorizing specific transactions by verifying that the conditions for the tokens associated with the specific transactions are met (see col.4 lines 7-11).

Re claim 42. Checchio further discloses a computer-readable medium comprising: program code for receiving from an account holder an indication of one or more conditions for completing one or more transactions (see fig.1 element s6); program code for associating a token with the one or more conditions in a token log that is accessible by an institution that is responsible for authorizing one or more transactions involving a financial account (see col.4 lines 15-40); and program code for facilitating the initiation of a transaction involving the financial account by providing the token and an indication of the account to a vendor (see fig.1 element s3), wherein the vendor is to provide the token, the indication of the account, and information about the transaction to the institution responsible for authorizing that transaction (see fig.1 element s5, also see col.3 10-45) which authorizing institution provides the vendor with transaction authorization based on the one or more conditions associated with the token in the token log being satisfied (see fig.1 element s8, also see col.4 lines 1-30).

Re claim 43. Checchio further discloses the computer-readable medium of claim 42,

Art Unit: 3696

further comprising: program code for receiving the token, the indication of the account, and the transaction information from the vendor (see fig.1 element s5); program code for checking whether the one or more conditions associated with the token in the token log are satisfied (i.e., a token match, see fig.1 element s8, also see col.3 lines 9-46); and program code for notifying the vendor that the transaction is authorized responsive to the one or more conditions being satisfied (see col.4 lines 5-14) (see col.3 lines 10-66, more specifically col.3 lines 47-66).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 11-13, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Checchio.

Re claim 11. Checchio does not explicitly disclose the method of claim 5, wherein a transaction condition includes a time-frame in which one or more specific transactions

are to be completed. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Re claim 12. Checchio does not explicitly disclose the method of claim 5, wherein a transaction condition includes a number of times a specific token may be used to authorize transactions. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Re claim 13. Checchio does not explicitly disclose the method of claim 5, wherein a transaction condition includes a minimum time interval between uses of a specific token to authorize transactions. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Re claim 36. Checchio does not explicitly disclose the system of claim 31, wherein the

Art Unit: 3696

specific conditions include a time-frame in which one or more specific transactions are to be completed. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Re claim 37. Checchio does not explicitly disclose the system of claim 31, wherein the specific conditions include a number of times a specific token may be used to authorize transactions. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Re claim 38. Checchio does not explicitly disclose the system of claim 31, wherein the specific conditions include a minimum time interval between uses of a specific token to authorize transactions. However, official notice is taken that it is old and well-known in the financial world to add a time-frame to a financial transaction. Thus, it would have been obvious to one of ordinary skill in the art to incorporate what is old and well-known in the art into Checchio's to allow the financial transaction to be completed at a specific time.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571)272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3696